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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,633	02/27/2004	Kevin L. Bokelman	200312941	1193

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EXAMINER

JOERGER, KAITLIN S

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,633

Applicant(s)

BOKELMAN ET AL.

Examiner

Kaitlin S. Joerger

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims 1, 6, and 18 all claim that the flag remains in one angular position for a portion of time while the medium is moving and in contact with the flag. The claim language suggests that “a portion of time while the medium is moving and in contact with the flag” is referring to the entire portion of time along the transport path that the sheet is in contact with the flag. This “portion of time” is depicted in figures 4, 5, and 6. These figures clearly show that the flag is moved during this “portion of time” and therefore does not remain in one angular position. Therefore, this feature is unclear to the examiner as the figures that show the travel path of the sheet beneath the sensor clearly show that the flag rotates to different angular positions.

Further none of the claims claim sufficient structure for the examiner to determine the metes and bounds of the claim. The independent claims claim a flag that performs a certain function, but there is insufficient structure in the claims to allow that function to be performed. The invention, as claimed in the independent claims, claim a simple flag, and does not include structure that would allow the flag to determine four different paper positions. The claims are being interpreted in their broadest manner, and as such, the examiner is unable to determine how

Art Unit: 3653

the flag of the invention is able to perform the claimed function. The detailed description, specifically paragraphs 0031 through 0042, as highlighted by the applicant specifies such necessary structure, such as blocking portions and windows, which would enable the flag to perform the claimed functions.

Response to Amendment

The declaration filed on 25 July 2006 under 37 CFR 1.131 is sufficient to overcome the Carter et al. (U.S. Patent 6,926,272) reference.

Response to Arguments

Applicant's arguments filed 25 July 2006 have been fully considered but they are not persuasive. The applicant has argued that the claim language clearly claims the invention and therefore the rejection under 112 2nd paragraph should be withdrawn. The examiner has not found these arguments to be persuasive, and maintains the position that the claims are written in indefinite language and that one of ordinary skill in the art cannot determine what the applicant is claiming. Specifically, the way in which the independent claims are written it suggest that the "portion of time" being claimed is the enter portion of time that the sheet is in contact with the flag. If this is true, the figures clearly show that the flag rotates and does not remain in one angular position. In addition, the claims do not include sufficient structure to enable the claimed flag to perform the claimed function of detecting the sheet at four distinct positions. A standard flag, as one of ordinary skill in the art would understand, moves between a position blocking a sensor and a position not blocking the sensor, and therefore would only be able to detect to

Art Unit: 3653

different states of media, not four. Therefore when interpreting the claims in their broadest manner one of ordinary skill in the art would not be able to determine how the flag performs the claimed function.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

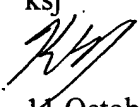
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ksj


11 October 2006


PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600